

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Raterman et al.

Appeal No. _____

Serial No.:	10/699,301
Filed:	October 31, 2003
Art Unit:	3637
Examiner:	Janet Marie Wilkens
Applicant:	John M. Raterman et al.
Title:	SUPPORT AND STORAGE SYSTEM FOR AN ADHESIVE DISPENSING UNIT
Attorney Docket:	NOR-1152
Confirmation No.:	3926

September 18, 2006

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

AMENDED BRIEF ON APPEAL

This brief is in furtherance of Appellants' Notice of Appeal filed June 29, 2006, appealing the decision of the Examiner dated April 12, 2006, finally rejecting claims 1-14 (all pending claims), and responds to the Notification of Non-Compliant Appeal Brief mailed August 30, 2006. A copy of the claims appears in the Claims Appendix to this brief.

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I. Real Party in Interest

The real party in interest is Nordson Corporation, of Westlake, Ohio, which is the Assignee of the present invention.

II. Related Appeals and Interferences

There are no related appeals or interferences known to the Appellants or the Appellants' legal representative which will directly affect, or be directly affected by, or have a bearing on the decision of the Board in the present appeal.

III. Status of Claims

Claims 1-14 remain pending in the application after the final rejection mailed April 12, 2006, and are subject to this appeal. Claims 1, 2 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,283,690 to Munson. Claims 1, 6 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,956,367 to Lyons. Claims 1-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,740,851 to Woodlief et al., in view of U.S. Patent No. 1,782,898 to Hunter et al.

IV. Status of Amendments

An Amendment after Final Action was filed June 23, 2006, to amend claims 1 and 8. This amendment was not entered.

V. Summary of Claimed Subject Matter

Claims 1 and 8 are independent claims. Below, Appellants have provided a summary of the claim language mapped to the supporting disclosure of the exemplary embodiment for representation purposes only.

Claim 1 recites an apparatus 10 for mounting an adhesive dispenser 12, as depicted in FIGS. 1 and 2. The apparatus 10 includes a base 14 defined by sidewalls 16 and a top surface 18. The base 14 is provided with various features to facilitate storage and use of various tools, parts, manuals, or other items which may be used by operators during operation or servicing of the adhesive dispensing unit 12. (Application at paragraph 0013.) These features may include one or more of a storage bay 20 through sidewall 16, a drawer 22 slidably coupled to the base 14 through sidewall 16, a slide out shelf 24 through sidewall 16, and a swing out plate 26. (Application at paragraphs 0013-15.) The bay 20 and drawer 22 are useful for storing manuals, tools, notebooks, and various other items useful for operation of the adhesive dispenser 12. (Id.) The shelf 24 and plate 26 may be used to support manuals, tools, parts, or various other articles in connection with operation or serving of the dispensing unit 12. (Id.)

To secure an adhesive dispensing unit 12 to the top surface 18 of the base 14, the apparatus 10 includes a coupling member comprising a generally flat plate 34 that is securable to the top surface 18 of the base 14. (Application at paragraph 0015.)

Claim 8 is directed to an apparatus for dispensing liquid adhesive, as depicted in FIG 1. Claim 8 includes the features recited in claim 1, and further recites an adhesive dispenser 12.

VI. Grounds of Rejection to be Reviewed on Appeal

I. The rejections of claims 1, 2 and 6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,283,690 to Munson, and the rejections of claims 1, 6, and 7 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 2,956,367 to Lyons.

II. The rejections of claims 1-14 under 35 U.S.C. §103(a) as being obvious in view of U.S. Patent No. 6,740,851 to Woodlief et al. in combination with U.S. Patent No. 1,782,898 to Hunter et al.

VII. Argument

A. The Rejections of Claims 1, 2, 6 and 7 under 35 U.S.C. §, 102(b)

Claims 1, 2 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,283,690 to Munson. Claims 1, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,956,367 to Lyons. Claim 1 is the only independent claim of this rejected group and is directed to an apparatus for mounting an adhesive dispenser, comprising:

- a) a base defined by at least one sidewall and a top surface, said base including at least one of:
 - i) a storage bay formed through said sidewall,
 - ii) a drawer slidably coupled to said base, through said sidewall, for movement between an open position wherein said drawer extends outwardly of said sidewall and a closed position wherein said drawer is received within said base,
 - iii) a shelf slidably coupled to said base for movement between an open position wherein said shelf extends outwardly of said sidewall and a closed position wherein said shelf is received within said base, and

- iv) a swing-out plate pivotally coupled to said base, through said sidewall, for movement between an open position wherein said plate extends outwardly of said sidewall and a closed position wherein said plate is received within said base; and
- b) a coupling member proximate said top surface of said base and configured to removably secure the adhesive dispenser to said top surface.

The Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference." Verdagal Bros. v. Union Oil Co. of Calif., 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(citation omitted). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons ordinary skill. Inherency may not be established by probabilities or possibilities.'" In re Robertson, 49 USPQ2nd 1949, 1950-51 (Fed. Cir. 1999)(citations omitted). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The rejection of claim 1 should be reversed because neither Munson '690 nor Lyons '367 teaches or suggests each and every element recited in claim 1. Specifically, both Munson '690 and Lyons '367 are directed to bases for supporting telephones thereon. Accordingly, there is no teaching or suggestion in Munson '690 or Lyons '367 that the devices disclosed therein include "a coupling member proximate said top surface of said base and configured to removably secure the adhesive dispenser to said

top surface," as required by claim 1. The basis of the Examiner's rejection of claim 1 amounts to an assertion that Munson '690 and Lyons '367 inherently include coupling members configured to removably secure an adhesive dispenser thereon. Yet, neither Munson '690 nor Lyons '367 teaches or suggests such a coupling member, and the Examiner has failed to cite any reference that teaches or suggests that such a coupling member is necessarily present in the devices of Munson '690 or Lyons '367. For at least these reasons, Appellants respectfully request that the rejections of claim 1 over Munson '690 and Lyons '367 be reversed.

Claims 2, 6 and 7 each depend from independent claim 1. Accordingly, Appellants respectfully assert that the rejections of claims 2, 6 and 7 over Munson '690 or Lyons '367 should be reversed for at least the reasons stated above for independent claim 1.

B. The Rejections of Claims 1-14 under 35 U.S.C. §103(a)

Claims 1-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,740,851 to Woodlief et al. in view of U.S. Patent No. 1,782,898 to Hunter et al. Claims 1 and 8 are the only independent claims of this rejected group. Claim 1 is directed to an apparatus for mounting an adhesive dispenser, as discussed above, and claim 8 is directed to the combination of an adhesive dispenser with the apparatus of claim 1.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2143. To establish prima facie

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 180 USPQ 580 (CCPA 1974). The mere fact that elements of a claimed invention are known in the art is not, of itself, sufficient basis for an obviousness rejection. In re Katzab, 55 USPQ2d 1313 (Fed. Cir. 2000); MPEP §2143.01. Rather, there must be some motivation, teaching or suggestion in the prior art to make the combination, either explicitly or implicitly. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The rejections of claims 1 and 8 should be reversed because Woodlief '851 does not teach or suggest each and every element recited in these claims, and because there is no teaching or suggestion to modify Woodlief '851 to include a base as set forth in Hunter '898. Rather, the Examiner has simply alleged a motivation to combine the references based on the presence of the claimed elements in the cited references themselves. This is clearly hindsight reconstruction using Appellants' own disclosure.

The Federal Circuit has repeatedly held that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The combination of Woodlief '851 and Hunter '898 amounts to a hindsight analysis that uses Appellants' disclosure of the features of a base desirable for use with an adhesive dispenser as a blueprint for finding those features in the prior art, then combines those features on the basis that Appellants taught the desirability of the combination. The particular combination of features claimed by Appellants is not taught or suggested by either prior art reference, and it is simply not enough that these features exist. Appellants particular combination is

uniquely suited to a support for an adhesive dispenser. Neither Woodlief '851 nor Hunter '898 recognize, teach, or suggest the desirability of the particular combination recited claims 1 and 8. Because such hindsight-based reconstruction of a claimed invention is forbidden by current law, Appellants respectfully request that the rejections of claims 1 and 8 be reversed.

Claims 2-7 each dependent from independent claim 1, and claims 9-14 each depend from independent claim 8. Accordingly, Appellants respectfully assert that the rejections of claims 2-7 and 9-14 over Woodlief '851 in view of Hunter '898 should be reversed for at least the reasons stated above for independent claims 1 and 8.

Conclusion

For the reasons stated above, Appellants respectfully urge the Board to reverse the rejections of claims 1-14.

If there are any questions regarding the foregoing, please contact the undersigned at 513/241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. (Original) An apparatus for mounting an adhesive dispenser, comprising:

- a) a base defined by at least one sidewall and a top surface, said base including at least one of:
 - i) a storage bay formed through said sidewall,
 - ii) a drawer slidably coupled to said base, through said sidewall, for movement between an open position wherein said drawer extends outwardly of said sidewall and a closed position wherein said drawer is received within said base,
 - iii) a shelf slidably coupled to said base for movement between an open position wherein said shelf extends outwardly of said sidewall and a closed position wherein said shelf is received within said base, and
 - iv) a swing-out plate pivotally coupled to said base, through said sidewall, for movement between an open position wherein said plate extends outwardly of said sidewall and a closed position wherein said plate is received within said base; and
- b) a coupling member proximate said top surface of said base and configured to removably secure the adhesive dispenser to said top surface.

2.(Original) The apparatus of claim 1, further comprising:

an opening through said base and terminating at said top surface, said opening sized to receive a cable for providing power to the adhesive dispenser.

3.(Original) The apparatus of claim 1, wherein said coupling member comprises a plate securable to said top surface of said base and including a first dispenser engaging member configured to slidably engage the adhesive dispenser, and a second dispenser engaging member configured to bias the adhesive dispenser into engagement with said first dispenser engaging member.

4.(Original) The apparatus of claim 3, wherein said plate includes a generally planar surface extending between first and said second edges and further comprising a flange projecting outwardly from said planar surface and away from said top surface when said plate is mounted to said top surface.

5.(Original) The apparatus of claim 4, wherein said flange includes a horizontal leg extending substantially parallel to said planar surface, said horizontal leg being adapted to capture a portion of the dispenser between said horizontal leg and said planar surface.

6.(Original) The apparatus of claim 1, wherein said coupling member further comprises a flange projecting outwardly from said top surface of said base.

7.(Original) The apparatus of claim 6, wherein said flange includes a horizontal leg extending substantially parallel to said top surface, said horizontal leg adapted to capture a portion of the dispenser between said horizontal leg and said top surface.

8.(Original) An apparatus for dispensing liquid adhesive, comprising:

- a) an adhesive dispenser; and
- b) a support for said adhesive dispenser, said support comprising:
- c) a base defined by at least one sidewall and a top surface, said

base including at least one of:

- i) a storage bay formed through said sidewall,
- ii) a drawer slidably coupled to said base, through said

sidewall, for movement between an open position wherein said drawer extends outwardly of said sidewall and a closed position wherein said drawer is received within said base,

- iii) a shelf slidably coupled to said base for movement between an open position wherein said shelf extends outwardly of said sidewall and a closed position wherein said shelf is received within said base, and

- iv) a swing-out plate pivotally coupled to said base, through said sidewall, for movement between an open position wherein said plate extends outwardly of said sidewall and a closed position wherein said plate is received within said base;

and

- d) a coupling member proximate said top surface of said base and configured to removably secure said adhesive dispenser to said top surface.

9.(Original) The apparatus of claim 8, further comprising:

an opening through said base and terminating at said top surface, said opening sized to receive a cable for providing power to said adhesive dispenser.

10.(Original) The apparatus of claim 8, wherein said coupling member comprises a plate securable to said top surface of said base and including a first dispenser engaging member configured to slidably engage said adhesive dispenser, and a second dispenser engaging member configured to bias said adhesive dispenser into engagement with said first dispenser engaging member.

11.(Original) The apparatus of claim 10, wherein said plate includes a generally planar surface extending between first and said second edges and further comprising a flange projecting outwardly from said planar surface and away from said top surface when said plate is mounted to said top surface.

12.(Original) The apparatus of claim 11, wherein said flange includes a horizontal leg extending substantially parallel to said planar surface, said horizontal leg being adapted to capture a portion of said dispenser between said horizontal leg and said planar surface.

13.(Original) The apparatus of claim 8, wherein said coupling member further comprises a flange projecting outwardly from said top surface of said base.

14.(Original) The apparatus of claim 13, wherein said flange includes a horizontal leg extending substantially parallel to said top surface, said horizontal leg adapted to capture a portion of said dispenser between said horizontal leg and said top surface.

IX. EVIDENCE APPENDIX

There is no evidence submitted in this Appeal.

X. RELATED PROCEEDINGS APPENDIX

1. There is no related proceeding in this Appeal.